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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,845	11/24/2003	Martin John Jones	ADI-099	3619

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GOODWIN PROCTER LLP  
PATENT ADMINISTRATOR  
EXCHANGE PLACE  
BOSTON, MA 02109-2881

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,845

Applicant(s)

JONES ET AL.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 25, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08252005</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7, 9, 13-16, 26-28 and 30-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Marmonnier 5,177,885. Marmonnier '885 discloses all the limitations of the claims including the following: a flexible upper for receiving a foot; a closure panel arranged at an instep of the flexible upper; a tightening element coupled to the closure panel and arranged at a heel region of the shoe; the tightening element operatively retaining the shoe on the foot by biasing the closure panel against the instep area along a substantially downward and rearward direction (the panel move rearwardly and downwardly, in the instep area, when tightened); the closure panel three-dimensionally encompasses the instep area of the upper; the closure panel comprises a side region extending to at least one of a lateral rear side and a medial rear side of the shoe for connecting the closure panel to the tightening element; at least one lateral receiving element and a medial receiving element; a portion of the closure panel is slidable within the receiving element when the tightening element is operated to bias the closure panel against the instep area of the upper; the closure panel comprises a side region projecting to at least one of a lateral front side and a medial front side of the shoe; the side region of the closure panel attached to at least one of a lower forefoot portion of the upper and a sole of the shoe; the closure panel defines a ventilation opening; the tightening element is connected to the closure panel by a pulling element to transmit a force to the closure panel; the pulling element is securable to the closure panel in at least two different locations; the tightening element comprises a lever mechanism; the lever mechanism comprises a pivotable lever couplable to a pulling element; the lever is attached releasably to the heel region; a closure panel disposed

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about an instep portion of the shoe; a tightening element coupled to the closure panel and arranged at a heel of the shoe; the tightening element operatively adjusting the pressure applied by the closure panel on the instep portion of the shoe; the tightening element has a primary loading path disposed at an acute angle relative to a ground engaging surface of the shoe; the primary loading path is disposed at an angle of about 20 degrees to about 35 degrees relative to the ground engaging surface; the primary loading path is disposed at an angle of about 27 degrees relative to the ground engaging surface; the closure panel comprises flexible material (plastic has some flexibility); the closure panel is adapted to conform flexibly to the instep area of the upper (see Figure 4, panel conforms to instep area of upper); the closure panel is on the exterior of the upper (see Figure 4); the closure panel is fixedly anchored to at least one of the lower forefoot portion of the upper and the sole (see Figure 4 at 22).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marmonnier 5,177,885 as applied above in view of WO 95/22917 (WO '917). Marmonnier '885 as applied above discloses all the limitations of the claims including the cable extending on both the lateral and medial sides of the shoe from the tightening element to the closure panel (at 51 and 51a). Marmonnier '885 does not teach the pulling element comprising at least one sheathed cable extending from the tightening element to the closure panel, the receiving element encompassing a rear portion of the upper from below the upper and the cable extending at least partially below an insole of the shoe. WO '917 teaches that the cable attached to the pulling element can be sheathed (see Figure 6) and extend below the insole (shown

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in Figure 6). WO '917 also teaches that the receiving element can encompass a rear portion of the upper from below the upper (i.e. inside the shoe). All of this aids in hiding the cable and giving a better aesthetic look. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the cable of Marmonnier '885 inside a sheath, as taught by WO '917 to protect the cable from scrape and dents that could weaken the cable. It also would have been obvious to encompass the rear portion of the upper from below the upper and extend below the insole to aid in hiding the cable from view of the user and others for a better looking exterior.

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marmonnier 5,177,885 as applied to claim 16 above in view of Baggio et al. 4,694,592. Marmonnier '885 as applied to claim 16 above discloses all the limitations of the claims except for the heel region comprising a plurality of upwardly directed projections defining grooves adapted for releasably receiving the lever and the pulling element coupled to the lever via an adjustment mechanism to adjust the force applied to the pulling element caused by pivoting the lever. Baggio et al. '592 teaches that it is desirable to have a plurality of upwardly directed projections 21 to allow for the pulling element 11 to be able to adjust the adjustability of the tension of the cable and therefore the boot to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place grooves such as that taught by Baggio et al. '592, on the heel portion of Marmonnier '885 to allow for adjustability of the tension of the cable and the closure to the user's foot.

***Allowable Subject Matter***

6. Claims 8 and 20-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 29 is allowed over the prior art of record.

***Response to Arguments***

8. Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive. Applicant's main arguments are directed to Marmonnier '885 on two points. 1.) that Marmonnier '885 does not teach the closure panel being biased "along a substantially downward and rearward directed load path" and 2.) the attachment point of the panel in Marmonnier '885 is not located in the forefoot area or sole area. With respect to point 1.), Marmonnier '885 teaches the panel is biased in a downward and rearward direction when the tightener is moved in a rearward direction. It appears applicant is arguing more than that which is claimed as the only requirement in the claim is that the panel, not the tightening mechanism, is moved in a downward and rearward direction, which occurs in Marmonnier '885 when tightened. Regarding point 2.), Marmonnier '885 shows the pane to be mounted in the sole area at location 22, thereby meeting this limitation in the claim.

***Conclusion***

9.) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS